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Supreme Court of the United States.

OCTOBER TERM, 1903.

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No. 53.

LA REPUBLIQUE FRANCAISE and LA COMPAGNIE FERMIERE DE L'ETABLISSEMENT THERMAL DE VICHY,
Petitioners,

vs.

THE SARATOGA VICHY SPRING COMPANY,
Respondent.

Brief of Argument on Behalf of Petitioners.

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BRIEF OF ARGUMENT ON BEHALF OF PETITIONERS.

This is a suit in equity brought to restrain the use of the word "Vichy" to describe or as the name or part of the name of a water not drawn from the Vichy Springs.

The suit was instituted in the United States Circuit Court for the Northern District of New York. That Court dismissed the bill. On appeal the Court of Appeals for the Second Circuit reversed the decision of the Circuit Court and granted an injunction, but limited the relief to restraining the respondent from using the word "Vichy" in connection with a water

not drawn from the Vichy Springs unless accompanied by the word "Saratoga" "as plainly and prominently displayed." The petitioners (the complainants below) thereupon applied to this Court for a writ of *certiorari* to review the proceedings in the Circuit Court of Appeals which was granted and the case is now before the Court under that writ.

The complainants in the case are La Republique Francaise (for convenience referred to hereinafter as the Republic of France, or France) and La Compagnie Fermiere De L'Etablissement Thermal De Vichy (referred to hereinafter as The Vichy Company), owner and lessee respectively of the Vichy Springs.

The bill sets forth that the complainant La Republique Francaise is an independent State, and one of the sovereign powers of the earth; that the other complainant, the Vichy Company, is a corporation existing under the laws of France; and that the defendant is a corporation existing under the laws of the State of New York, and a citizen of said State.

It is recited that there is in France a certain commune or town by the name of Vichy which has been known throughout the civilized world for ages and as being renowned for the waters obtained from the numerous mineral springs situated therein which have been universally called and known as "Vichy" waters.

It is set forth that the complainants are owner and lessee respectively of the Vichy springs, and the facts which support the allegations of ownership and possession of the springs are recited in detail.

It is alleged that the complainants are entitled to the exclusive use and enjoyment of the springs referred to, including the right to use the name "Vichy" in

connection therewith, and are equitably entitled to be protected against any and every use of the designation "Vichy" to describe, or as a name of a water not drawn from their springs.

It is charged that the defendant, The Saratoga Vichy Spring Company, is now and for some time past has been fraudulently and unlawfully making use of the complainant's said designation "Vichy" as a name or designation for a certain water or waters by it, the defendant, taken or drawn from a certain natural spring at or near Saratoga, New York.

Copies of the labels used by the defendant are produced with the bill, and the charge is made that the labels are specifically misleading and fraudulent.

Complainants' prayer is in substance that there should be a decree that the use by The Saratoga Vichy Spring Company of the word "Vichy" as a name or designation for the waters drawn from the said spring at Saratoga is a violation of complainants' rights and that the defendant be restrained from using the word "Vichy" as the name or as part of the name or to denote a water not drawn from the springs of the complainants, and that whatever may be true as to the respondent's rights to use the word "Vichy" the use of the labels produced with the bill should be enjoined.

The answer denies all the allegations of the bill relating to the corporate character of the complainant, The Vichy Company, and the exclusive possession and ownership of the Vichy Springs. It alleges that the complainants have no exclusive right, even in France, to the use of the designation "Vichy" in connection with water, that the name "Vichy" has been *publici juris* in the United States for many years, and that

defendant's use of the word "Vichy" has been in every way fair and legitimate.

The record consists to a large extent of stipulations of counsel setting forth the material facts. The record in the case of these complainants against one Schultz is made a part of the present record, the object being to give complainants the benefit of the proof of title contained in that record and the defendant the benefit of the proof of adverse use of the word "Vichy" and other things.

We understand that all the material allegations of our bill as to the history of the Vichy Springs, the ownership of the French Republic, the lesseeship of the Vichy Company and other facts which tend to establish our right to sue are not disputed; and there is as little doubt that the acts of the defendant of which we complain are not sought to be denied.

The material facts may be summarized as follows:

The commune or town named Vichy has been known throughout the civilized world for a long time as being renowned for the waters obtained from numerous mineral springs situated in said commune, the waters of which springs have been for many years universally called and known as "Vichy" waters. Since the treason of the Constable of Bourbon in the year 1531 these springs have been owned by the State of France which, under the law of France, is entitled to the exclusive use and enjoyment of the springs referred to, including the right to use the name "Vichy" in connection therewith.

The Vichy Company is the sole lessee of said

springs for a term of years, paying the sum of one hundred thousand francs for the privilege of occupancy, by whom the waters of the springs have been for many years bottled and sold over all the civilized world.

The exportation of the waters was commenced before 1716. In 1853 the waters were exported directly to this country, and in 1893 the shipments to this country were about three hundred thousand bottles. In 1896 the entire shipments of Vichy amounted to nearly ten million bottles.

In 1872 a spring was discovered in the township of Saratoga Springs, in the State of New York, the water of which differs from the water of the Vichy Springs in ingredients and taste. This Saratoga water was bottled and sold in 1873, and thereafter until 1876, by the owners of the spring, when the defendant, under the name of the Saratoga Vichy Spring Company, became the owner and has since sold the water, using various bottles, circulars, and, since the year 1885, labels of various kinds, hereinafter described more in detail.

Until 1896 the words " Saratoga " and " Vichy " upon the labels were substantially in the same size and style of type. In 1896 a neck label was adopted upon which the word " Vichy " was displayed very prominently and the word " Saratoga " in far less conspicuous type, and similar uses of the two words were then made in circulars and otherwise.

There have been other uses of the word " Vichy " in the United States (which were considered by the Courts below) in connection with manufactured waters, but the defendant alone has made use of the word in connection with a natural water. The uses of the

word " Vichy " by others may be summarized as follows :

Factitious waters have been put upon the market in the United States under the name of " Vichy " since 1862. These waters have differed widely from each other in composition and therapeutic effect, some approaching in some degree the composition of the genuine " Vichy," others being no more than ordinary water, with a slight trace of chloride of sodium. Upon these waters the word " Vichy " has been used recklessly and adventurously, and without any certain or definite meaning, and the word " Vichy," except as indicating that the water sold under it is drawn from the French wells, has meant nothing.

The word " Vichy," notwithstanding the use, hit or miss, to describe these factitious waters, has never lost its original and true meaning, but to-day, as always, in the words of the Circuit Court of Appeals, " Vichy properly signifies water from the French wells."

As a matter of fact neither the French Republic nor the Vichy Company had actual knowledge of any use of the word " Vichy " in this country until shortly before action was taken in 1892 to correct the wrong. It is perfectly obvious that they might, by inquiries in the United States, have ascertained that various persons were selling waters under the name of " Vichy," but as a matter of fact the complainants were ignorant of the use of the word.

We digress to point out in this connection that not only was there no actual acquiescence but it is impossible to find in the case any circumstances which can be construed as imposing on the complainants the duty to send to the United States or instruct those to whom their goods were consigned to make investigations with

a view to discovering opportunities to institute suits. If, however, it was the complainants' duty to inform themselves as to what was being done in the United States and there was a constructive acquiescence covering a considerable period, it is certainly not a reasonable assumption that this period was as long as the dates (1862 to 1892) suggest. For years the business of selling the imitation waters must have been of inconsiderable proportions, and at the time the adverse use of the word " Vichy " commenced the demand for mineral waters in the United States was of ltttle importance, and the commercial relations existing between the United States and France were quite different from what they were at a later date. We think it is impossible to fix a date from which the imputation of laches can be made to run, and if there is any doubt, that doubt should not be resolved in favor of the defendant.

As soon as the complainants received actual knowledge in the premises, in January, 1892, suit was commenced against one Schultz, by far the most conspicuous example of the limited class who had bottled their factitious waters and represented them to be " Vichy " and sold them as such. Until the suit was commenced against Schultz his water had been unblushingly labelled and represented to be " Vichy (Grande Grille)," —" Grande Grille " being the name of one of the Vichy Springs—and nothing else. After the suit was commenced Schultz changed his label first by substituting for the designation " Grande Grille " the words " Manufactured by " in very inconspicuous type, and finally by adding the word " Artificial " in type of the same size as that in which " Vichy " was printed.

Schultz died before the hearing of said suit, and the case was continued against his executrix and was not finally disposed of until after the complainants instituted this suit against this defendant. The death of Schultz, *pendente lite*, precluded any determination of the complainants' rights in said suit against Schultz except in so far as the right to recover profits was concerned. The opinions of the Circuit Court and the Circuit Court of Appeals in said suit against Schultz are reported in 94 Fed. Rep., 500, and 102 Fed. Rep., 153.

There have been introduced into the record other uses of the word "Vichy" which are not referred to by the courts below and which are, we conceive, of no possible consequence. These uses have consisted of (**1**) the use of the word in the Struve establishments, which concern things of which the complainants never heard done or contemplated by Struve many years ago in Russia, or Germany, or other foreign jurisdictions where the complainants were without remedy and where the laws are very different from the enlightened rules of this Court by which, we understand, the case is governed, and (**2**) the haphazard use of the word by retail druggists, who draw their uncertain waters from soda fountains and the like, which use has been different in kind from the use of the word by the complainants and the defendant, and does not in any way affect the sale of the complainants' "Vichy" in the markets of the United States.

In the Court of first instance his Honor, Judge COXE, held that the case was controlled by a decision of his Honor, Judge WALLACE, in the suit brought by these complainants against Schultz, which proceeded on the ground that by reason of laches the complainants were without remedy, and dismissed the bill.

Upon appeal, the Circuit Court of Appeals held that the effect of the neck label displaying the word "Vichy" far more conspicuously than the word "Saratoga" "is to represent to the purchaser not accustomed to the article that is Vichy water, and Vichy properly signifies water from the French wells. It is in fact an untruthful label employed for an objectionable purpose" (Rec., p. 87). But the Court decided that the complainants' relief should be limited to compelling the defendant to print the word "Saratoga" "as plainly and prominently" as the word "Vichy."

Petitioner's Contentions.

We respectfully submit that the Court erred in not restraining the use of the word "Vichy" to describe or as the name or part of the name of water not drawn from the Vichy Springs.

The opinion of the Court of Appeals places the refusal to grant full relief upon the ground that the use of the qualifying word "Saratoga" prevents the confusion of the identify of the two articles because by lapse of time the two waters have come to be understood as distinct (Rec., p. 87).

We respectfully submit that because both waters are named "Vichy" "the short phrase between buyer and seller which indicates the wish to buy and the power to sell" (Congress Co. vs. High Rock Co., 45 N. Y., 291), mistake, confusion and fraudulent substitution are inevitable.

But we most earnestly submit that it may be true that the identity of the two articles is not confused without affecting our right of action. The water of the defendant (paying nothing in duties or for transportation) is sold as "Vichy" and satisfied the demand for "Vichy" (which demand is the good-will and property belonging to the complainants—in effect part of the land they own) and necessarily stands in the way of and precludes the importation and sale of the genuine "Vichy" water in the markets of the United States. If it be admitted, for the sake of the argument, that the identity of the two articles is not confused, it remains true that the use by the defendant of the word "Vichy" enables it to appropriate and satisfy the demand for "Vichy" and makes it impossible for the complainants

to have any trade in the United States, whereby the value of the land owned by the Republic of France is impaired by keeping the product of it out of this market. In effect, the defendant and the class it represents are, by the fraudulent use of the word "Vichy," withholding from the French Republic part of its property. Whether or not the identity of the two articles is also confused is a circumstance of secondary importance.

The only justification for this use of our designation is the plea of laches. We respectfully answer:

1. The Republic of France being the principal complainant, there can be no imputation of laches or acquiescence.

2. None of the evidence of adverse uses of the word "Vichy" (to which objection was seasonably taken) should have been considered, because it tended only to show a custom or usage which. because it was uncertain, unreasonable and grounded in fraud, should not have been considered by a court of equity.

3. If laches can be imputed to the complainants, it should have been regarded as having the effect of a revokable license, which is terminated by affirmative action.

We say that equity will not countenance laches, and that the plea of laches is a good defense to defeat the accounting day after day as long as the laches continues. But we think that it is equally true that equity will not make a title for the trespasser out of fraud, and when the injured party asks that the fraud be terminated his prayer will not be denied. We say that equity may punish him for his forbearance and

disinclination to sue by refusing to give him compensation, but it will not take his property from him and deliver it over to the wrongdoer. We contend that as long as a truthful use of the name can be differentiated from its use in a spurious relation, equity will protect the truth.

In the present instance the record establishes beyond question that whatever the extent of the adverse use of the name, "Vichy" has never lost its original and true meaning, but, as found by the Court of Appeals, "Vichy" to-day as always "properly signifies water from the French Wells." If laches can be imputed to the complainant, we think it was that "inexcusable laches in seeking redress" (96 U. S., 258; 128 U. S., 253; 163 U. S., 202; 179 U. S., 19), which because it has not defeated "the right itself" *(Ib.)*—because it has not destroyed the true meaning of the word—did not defeat the action, except with relation to the period covered by the laches. To yesterday's injury the complainants may have been inattentive. But concerning the injury of to-morrow they are exercising all possible vigilance.

4. And we say that by the treaty with France the protection of our name in the markets of the United States is guaranteed; that we may invoke that protection at any time, and that that right cannot be defeated or displaced by any species of misrepresentation or fraud no matter how long continued.

Before presenting our arguments in support of these contentions, we consider the evidence as to the title of the complainants and the uses of the word "Vichy" by the defendant and others in the United States."

THE FACTS.

The Petitioner's Title.

There is little dispute concerning the material facts. It is abundantly established that the Republic of France is and has long been the owner of the Vichy Springs (Rec., pp. 128, 129; *Ib.*, pp. 153–154; *Ib.*, p. 146, &c.; *Ib.*, p. 154, &c.), and that The Vichy Company, a corporation existing under the laws of France (*Ib.*, p. 141, &c.), is and has long been the sole lessee of said springs (*Ib.*, p. 140, &c., p. 130, &c.) by whom the waters of the springs have been for many years bottled, offered and sold all over the civilized world (*Ib.*, p. 142, &c.).

It is established that for many years, certainly for more than half a century, the complainants and their predecessors have enjoyed in France to all intents and purposes the exclusive right to the use of the designation "Vichy" as the name of a water. The evidence shows that the broad right which the complainants seek to assert in this case has been fully and continuously recognized and upheld by the Courts of France, and that any use of the word "Vichy" in France as a name or designation in connection with water not drawn from the springs of the Vichy basin would be prohibited by injunction (Rec., pp. 131, 137, pp. 141, 147, pp. 158, 151, p. 160, &c., p. 165, &c.).

The evidence of Count De Marafy, recently deceased (Record, ~~300~~ 167, &c.), whose writings have been referred to as of an authoritative character by this Court (163 U. S., 169), is of persuasive force (Rec., p. 166, &c., pp. 167, 168, &c.).

It is true that the French courts have refused to do

more than impose conditions in connection with waters not within the commune of Vichy that emanate "from the same hydrographical region, which may be called generally the Basin of Vichy" (Rec., p. 448).

The facts in this regard are that there are a few small springs on the borders of the commune of Vichy which are not strictly within the lines of the commune, and which are not owned by the French Government or leased to the Vichy Company, and that the word "Vichy" is used under certain restrictions in connection with the waters of these springs (R., pp. 440, 448).

But the water drawn from them is Vichy, because it possesses "identical or analogous qualities of therapeutics" (*Ib.*, 448), and because it is generically the same as all the waters of the Vichy spring or basin.

Nature has planted a single spring or basin with numerous outlets, and the water drawn at each of the outlets is Vichy. We own and control all the important outlets. The fact that other outlets deliver water from the same spring is of no consequence as affecting our rights in the premises.

The Courts have not accepted the reasoning which leads to the conclusion that because the suppression of a lie will benefit more than one person its continuance should be permitted.

Clark Thread Co. vs. Armitage, 45 U. S. Apps., 62, 72.

R. W. Rogers Co. vs. Wm. Rogers Mif. Co., 35 *Ib.*, 847.

Pillsbury, &c., Co. vs. Eagle, 86 Fed., 608, and cases cited.

In a case relating to a product of nature the right of action depends upon the proposition that the word

which is sought to be protected means a particular thing coming from a particular place or source of supply. The complainants' contention is that the defendant is guilty of fraud because he uses the word untruthfully to denote a product coming from some other place or source. It is axiomatically plain that the circumstance that the spring or mine has a number of outlets owned by different persons is immaterial as affecting the meaning of the word and the right to be protected in its use.

And it requires no argument to demonstrate that, in the absence of the affirmative defence relating to the use by the public in the United States of the name of complainants' spring, the case in all its parts would be with the complainants.

We assume that it is not necessary to take up the time of the Court with a discussion of this proposition:

> Congress & Empire Spring Co. vs. High Rock Congress Spring Co., 45 N. Y., 291;
> Radde vs. Norman, L. R., 14 Eq., 348;
> Raggett vs. Findlater, L. R., 17 Eq., 29;
> Apollinaris Co. vs. Norrish, 33 L. T. R. N. S., 242;
> Dunbar vs. Glen, 42 Wisc., 118;
> Anheuser-Busch Brewing Ass'n vs. Piza, 23 Blach., 245; 24 Fed., 149;
> Lever Bros. Limited vs. Pasfield, 88 Fed., 484;
> City of Carlsbad vs. Kutnow, 71 Fed., 167;
> Hill vs. Lockwood, 32 *Ib.*, 389, 395.
> Townsend, J., in opinion on the demurrer (Rec., p. 246 *et seq.*).

In the absence of laches or acquiescence the use by the defendant of the designation "Saratoga Vichy"

would be an obvious infringement of complainants' rights. There would be an invasion of complainants' generic right to the exclusive use of the designation "Vichy" and the employment of the prefix "Saratoga"—like "High Rock" to qualify "Congress," (45 N. Y., 291) "London" to qualify "Appolinaris" (33 L. T. R., 242) "American" to qualify "Sunlight," (88 Fed., 484), "Kutnow's Improved Effervescing," to qualify "Carlsbad" (71 Fed., 167) and so on*—would be held to be an immaterial circumstance which in no way justified the use of complainants' designation.

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*"Royal" and "Royal London," Royal Baking Powder Co. v. Raymond, 70 Fed., 376 (On appeal, 85 Fed., 231); "Glenfield" and "Royal Palace, Glenfield," Wotherspoon v. Currie, 5 H. L., 508; "Budweiser" and "Milwaukee Budweiser," Anheuser-Busch Brewing Association v. Fred Miller Brewing Co., 87 Fed., 864; "Health Food" and "Sanitarium Health Food," Fuller v. Huff, 104 Fed., 141; "Home" and "Home Delight," New Home Sewing Machine Co. v. Bloomingdale, 59 Fed., 284; "Sanitas" and "Condi-Sanitas," Sanitas Co. v. Condy, 56 L. T., N. S., 621 (4 R. P. C., 195); "Portland" and "Famous Portland," Van Horn v. Coogan, 52 N. J. Eq., 380 (28 Atl. Rep., 788); "Roy Watch Case Co." and "Camm-Roy Watch Case Co.," Roy Watch Case Co. v. Camm-Roy Watch Case Co., 59 N. Y. Supplement, 979; "Star" and "Lone Star," Hutchinson v. Covert, 51 Fed., 832; "Cashmere" and "Violets of Cashmere," Colgate v. Adams, 88 Fed., 899; "Hohner" and "Improved Hohner," Hohner v. Gratz, 52 Fed., 871; "Queen Quality" and "Queen," Thomas G. Plant Co. v. May Co., 105 Fed., 375; "Pride" and "Pride of Syracuse," Hier v. Abrahams, 82 N. Y., 519; "German Household

The conduct of the defendant has been at all times fraudulent. When the spring was discovered it was called "Ætna" (Rec., p. 46). Soon after the discovery the name of the spring was changed to "Saratoga Vichy Spouting Spring, Saratoga, New York."

The appropriation by the defendant of the word "Vichy" was "without a shadow of justification and in fraud of plaintiff's rights" (179 U. S., 19, 37). The water of the defendant's spring may be unmistakably palatable and wholesome and useful for all the purposes for which it is recommended, but it is in no conceivable sense "Vichy."

We quote from a book put out by Schultz and for many years used in connection with his business:

> "Some Saratoga waters are named after famous European springs—for instance, *Saratoga Vichy.* Most people are misled by the name, believing the water to be similar in composition and effects to *Vichy*, which is the great *alkaline* water, *carbonate of soda being its predominant ingredient.*
>
> "Here is a comparative analysis of both waters,

Dyes" and "Excellent German Household Dyes," Oppermann v. Waterman, 94 Wis., 583 (69 N. W. Rep., 569); "Guinea Coal Co." and "Pall Mall Guinea Coal Co.," Lee v. Haley, L. R., 5 Ch., 155; "Le Page's Liquid Glue" and "Le Page's Improved Liquid Glue," Russia Cement Co. v. Le Page, 147 Mass., 206; "The American Grocer" and "The Grocer," American Grocers' Pub. Co. v. Grocers' Pub. Co., 25 Hun, N. Y., 398; *Accord.*

showing their three principal ingredients in 100,000 parts :

	Vichy (Grande Grille).	Saratoga Vichy.
Carbonate of Soda	380.130	89.660
Chloride of Sodium	57.878	220.660
Carbonate of Lime.....	25.003	101.124

" It will be seen at a glance that chloride of sodium is the predominant ingredient in Saratoga Vichy—*just as in all other Saratoga waters*—that carbonate of lime comes next, and that carbonate of soda is the smallest. With the three principal ingredients *differing about 400 per centum each* from real Vichy the use of that name does not appear to be justified " (Rec., p. 226).

This statement is supported by other evidence contained in the record. As found by the learned Judge in the Court of first instance, " The two are different in appearance, taste and ingredients " (Opinion of Coxe, J.), and yet the defendant says, repeatedly and continuously, that the use of the name " Vichy " in connection with its springs is justified in part by the fact that the water is substantially like the springs of the complainants.

In every possible aspect the use by the defendant of the designation " Vichy " is arbitrary, misleading and inequitable.

We submit that it is impossible to doubt that the word " Vichy " was selected by the defendant to pro-

mote and enable the sale of the water of its spring upon the reputation of the famous Springs of Vichy.

And the circulars used continuously from the first by the defendant to market its water amount to a demonstration that the appropriation of the word was for the purpose of trading upon the reputation of the complainants' springs.

The defendant has from the first recommended its product as being, for example, "superior to the French Vichy" (Rec., p. 59), "just as good" (*Ib.*, p. 37), and because of its "wonderful similarity to the Vichy waters of France" (Rec., p. 53).

It may be said of these advertisements, as was recently said of similar advertisements by the English Court of Appeal:

> "Of course, it would never do, it would not suit them at all, to advertise goods in a way which would have the direct result of sending people to their rivals. The object is to make it clear who the advertisers are by giving a sufficient address, and only to hint at the other people who are in the background—to attract to one's self by the suggestion of your competitor" (Valentine vs. Valentine, 17 R. P. C., 673, 685).

See, also,

Croft vs. Day, 7 Beav., 84.
Menendez vs. Holt, 128 U. S., 514.

The appropriation of the name of the famous springs speaks for itself, and the various ways in which the defendant has used the name "Vichy" and the *indicia* availed of to accompany it remove any doubt concerning the purpose of the appropriation.

The evidence is that the complainants have used one style of bottle for forty-five years, which has continued to be the same (Rec., p. 30).

The defendant had in use a bottle without any labels, which it used for a number of years until 1885, when it adopted another and different bottle with a white label, which it used until about the year 1888.

In 1888, for reasons which are not set forth, the bottle it then had in use and which had been used for years, was discarded and abandoned, and a bottle which was in shape, color, and otherwise, to all intents and purposes, exactly like that of the complainants', was adopted, and at the same time a label in size and general character an obvious imitation of complainants' label was devised and adopted for use in connection with the simulated bottle (Rec., pp. 48–67).

This inequitable bottle and label defendant used until the year 1896, and it is admitted that the water put up in this way was on sale in the City of New York at the time the bill was filed (Rec., p. 49).

And it is shown that, discontinuing the use of the style of circulars it had previously used, the defendant put out and for years employed circulars consisting in part of representations of the simulated bottle and label (Rec., pp. 37–69).

At a little distance, or to a person buying hurriedly, or to an incautious purchaser, the water of the defendant, as it was put up for a number of years prior to 1896, was obviously very similar to the imported water, and obviously similar unnecessarily, and by the choice and selection of the defendant.

Whatever may be true of the word "Vichy," the defendant's article thus dressed admits of no possible justification (Singer Manfg. Co. vs. June Manfg. Co., 163 U. S., 202).

And when after years of experience the defendant made its last choice of labels, it caused to be devised

a label which was applied upon the neck of the bottle so that it was not washed off when the water was put on ice, and was, we think, the principal means of identification which gave a name to the package, and in constructing which pains were taken to apply the word "Saratoga" in comparatively small type so that it was not likely to attract attention, and so that the qualifying word was effectually dominated by and lost in the word "Vichy."

In the words of the Court of Appeals, "It is, in fact, an untruthful label, employed for an objectionable purpose" (Rec., p. 87).

The same over accentuation of the word "Vichy" is to be found in the defendant's advertisements (Rec., p. 41), and as part of the circular issued in connection with the water carrying the last label (Rec., p. 39).

That this use of the word "Vichy" cannot be justified is demonstatred by many authoritative cases (Royal Baking Powder Co. vs. Royal, 122 Fed., 337; American Waltham Watch Co. vs. U. S. Watch Co., 173 Mass., 85; 53 N. E., 141).

And the defendant's acts are peculiarly inequitable by reason of the fact that its water is a natural water and not a manufactured product. In the case of the factitious waters to ask for natural "Vichy" was at once to exclude the artificial product. In the present instance to ask for natural "Vichy" is to exclude the artificial product and to include the product of the defendant. The defendant has continuously on its labels and in its circulars recommended its water in many ways as "a pure natural 'Vichy'" (Rec., p. 53), and in many ways emphasized the caution, "Beware of artificial Vichy" (Rec., pp. 39, 49, 71).

The use of the word "Vichy" by this defendant

cannot be justified upon the theory, if any such theory were possible, that artificial "Vichy" means a water manufactured according to accepted analyses of the water of the complainants' springs. Its water is in no sense "Vichy" and it is sold as natural "Vichy." It cannot bring its acts within the usage of the name "Vichy," if such a usage could be considered, to which most of the evidence on the part of the defendant relates. The defendant's acts are *sui generis*. It has no defense but its own wrong.

Said Lord Justice JAMES:

> "It has been said that one murder makes a villian and millions a hero, but I think it would hardly do to act on that principle in such matters as this, and to say that the extent of a man's piratical invasions of his neighbor's rights is to convert his piracy into a lawful trade. That ground of defense, therefore, in my judgment, fails" (Ford vs. Foster, L. R., 1872, 7 Ch. A., 611, 624).

Obvious fraud continued for a period of years in connection with the abandonment of an honest bottle and the adoption and use of a simulated bottle and label, "ought not, unpon principles of eternal justice, to be admitted to repel relief" (6 Wheat., 481, 497).

The adverse uses of the word "Vichy," however general and long-continued, were all of them essentially unfair and equivocal.

As has been pointed out, the waters of the defendant's spring are widely different from "Vichy" in taste and ingredients. The veteran witness of the defendant in the Schultz case says: "My Vichy is totally different from the imported by its external

appearance and by the intrinsic effect" (Rec., p. 404). The evidence leaves no room for doubt that the word "Vichy" has no definite meaning, except as it indicates the waters of the Vichy Springs. The uses of the word described by defendant's witnesses are baldly loose and inaccurate. Because they show only that there has been a fraudulent and misleading use of the word "Vichy," hit or miss, to describe all sorts of water which has not destroyed the original and true meaning of the word, we think these uses of the word have no bearing upon the questions which the Court is called upon to decide. But in view of the quantity of evidence taken, we present a summary of the adverse uses of the word :

1. It has been used arbitrarily in connection with water drawn from a soda fountain to indicate any alkaline water charged with carbonic acid gas.

This use of the word "Vichy" we think may be laid out of sight. As the word has been used in serving consumers at soda fountains it has signified according to much of defendant's evidence "simply an alkaline water" (Rec., p. 375).

But it will not be contended for a moment that when a a physician, whose prescription has reference to water in bottles or siphons only, recommends the use of Vichy, he means any alkaline water, be what it may be, which contains carbonic acid gas. He means a water in bottles or siphons at least containing the "true components of the genuine springs" (Rec., pp. 268, 320, 339, 341).

The demand for a water to be transported from place to place or used at the table is not supplied by a water which is put up in such a way that it must be dispensed from a soda fountain.

It is certain that the use of the word "Vichy" in connection with a demand for an effervescent water to be consumed as soon as it is drawn is a very different thing from the use of the same word by means of labels and otherwise for water put up and sold in bottles.

And we submit that it is not reasonable to hold that there was imposed upon these complainants the duty to ascertain the things being done in the drug stores of the United States which did not to any extent affect them or interfere with their trade.

In the concrete case at bar it appears that the output of the defendant's springs is offered directly and specifically in bottles in competition with the output of the complainants'. To ask for "Vichy" at a store where the waters are kept is, in the absence of explanation to describe at one and the same time the goods of both parties. They are both labeled "Vichy," each bidding for the same demand and seeking to supply the same wants.

Proof, therefore, that the name "Vichy" has been used for years in drug stores in connection with an effervescent alkaline water which has been drawn from a soda fountain and at once consumed need not be considered in this case.

2. The Struve Establishments were emphasized in the testimony taken by the defendant in the case against Schultz. It appears that Struve began his operations in 1840 and opened numerous establishments where he made use of the names of all the principal springs, as we understand, in connection with waters drawn from fountains (Rec., pp. 413–415),

The evidence deduced is in the form of extracts from publications put out by Struve and others describing what he contemplated and was doing.

From our point of view all the evidence relating to the Struve Establishments is immaterial:

(**a**) It is conclusively established that the complainants have "never known of artificial water manufactured by Dr. Struve" (Rec., pp. 144, 148, 152).

(**b**) With the possible exception of Brighton, England, the proof concerning which is too general and indefinite to be of any value, whatever use there was by Struve or his son of the word "Vichy" took place in Germany, where, we understand, the owners of the Vichy Springs were without remedy. It may be true that the laws of Germany, etc., in effect protected Struve in the manufacture of his "imitated waters" (Browne on Trade Marks, Second Edition, 688, *Ib.*, Sup. 170). But that fact is without significance as affecting the rights of the complainants existing under the laws of the United States. In the absence of proof that there was a right of action against Dr. Struve the evidence of what he did is immaterial on its face, and if there was a right of action against Dr. Struve the omission to proceed did not impair the rights of the complainants to be protected against the operations of the defendant in the United States.

3. The evidence for the respondent which relates to waters sold in bottles or siphons establishes beyond question that the name "Vichy" has for a long time been applied in the United States to waters of many different kinds, but that it has never had a definite meaning except as it has denoted the genuine water drawn from the complainants' springs.

The uses of the name in connection with artificial waters sold in the United States are accurately summarized in the report of the principal expert witness

called in the Schultz case Dr. Endemann made shortly before the bill of complaint in that case was filed (Rec., p. 209), which is supported directly or indirectly by perhaps all the evidence offered on behalf of the defendant. This summary of the uses of the name "Vichy" together with explanatory matter which appeared in the "New York Tribune," in which the report was printed is for the convenience of the Court here reproduced :

"NATURAL AND ARTIFICIAL VICHY."

"The action of the Board of Health in regard to the use of impure waters from city wells the manufacture of mineral waters, as recently reported in 'The Tribune,' has started inquiries as to the quality of the medicinal spring waters such as Seltzer and Vichy, sold by manufacturers, in this city. In order to test the question, Vichy waters were purchased from twelve different manufacturers and submitted for analysis to a chemist of high standing, who reported as follows :

"GEORGE FRED HAYNES, ESQ. :

"DEAR SIR: I have examined the samples of Vichy left at my laboratory for analysis. Vichy is a medicinal alkaline water and is composed of fifteen different mineral ingredients, the sum total of which is about 100 times greater than that of Croton Water. It is, therefore, of the utmost importance that in artificial Vichy the different ingredients should be present in correct proportions, as its efficacy and value depend upon it. A margin of 10 per cent. either way in artificial Vichy as compared with natural Vichy should certainly be more than ample for a medicinal preparation. The results are given in the following table :

Analysis of Natural and Artificial Vichy Compared.	Carbonnate of Soda.	Chloride of Sodium	Total Solids.
Natural Vichy according to Bauer	380.1	57.8	506.5
1. Carl H. Schultz	380.2	57.6	508.2
2. Dr. Hanbury Smith	262.3	59.3	386.0
3. John Morgan	226.5	103.5	370.0
4. S. A. Ludin	190.8	61.0	227.5
5. Byrne Brothers	148.4	44.2	193.5
6. Hygeia Distilled W. C.	112.6	126.9	264.2
7. J. F. Meyer	74.2	213.7	343.0
8. Lighte & Bro.	66.2	73.5	141.0
9. Weymann Bros.	53.0	201.2	430.5
10. Rayner & Steele	66.2	137.0	224.0
11. Bolen & Byrne	53.0	3.3	66.0
12. Edward H. Walker	none	trace	8.5

"From this table it will be seen that but one water, No. 1 (Carl H. Schultz) agrees well with the natural Vichy.

"Respectfully yours,

DR. H. ENDEMANN.

NEW YORK, March, 28, 1889.

"This report will surprise the public, as it discloses the fact that only one water is manufactured in this city which closely appraches in composition the natural Vichy, while all of them are sold as Vichy, even in drug stores upon the prescription of physicians. Considering the large quantity of these waters used by the public, it is to be hoped that the medical profession will take the matter in hand and have the manufacture of mineral waters placed under official control (Rec., p. 209)."

This report is supported, directly or indirectly, by perhaps all the evidence offered on behalf of defendant. The proof is that the word "Vichy" has been

used, hit or miss, on waters differing widely from each other in composition and therapeutic effect.

The use most fully explored is that of Schultz, and to it we briefly direct attention.

The use of the name "Vichy" by Schultz was at all times fraudulent and has never ceased to be fraudulent.

Whether or not he sat down and said to himself "I propose to defraud my neighbor" (8 R. P. C., 181, 184) is not material. He acted with the fullest knowledge and deliberately did that which was necessarily calculated to injure the complainants, and "he must be taken to be guilty of fraud—that is to say, of knowingly injuring his neighbor—knowingly violating his neighbor's rights by some false pretense" (Pinto vs. Badman, 8 R. P. C., 181).

And we digress to say that it is not essential to our case to show that this defendant is animated by a vicious moral purpose "partly because a man is presumed to intend the natural consequence of his own act and partly because although he may have acted in ignorance in the first instance yet if he continues that course of conduct after he has got knowledge of the facts he then becomes guilty of fraud" (Chivers vs. Chivers, 17 R. P. C., 420, 430).

Whatever may be true of the necessity to show an immoral purpose in order to obtain compensation for past injury—a question which has given rise to some discussion (16 Harvard Law Review, p. 272)—there is no room for difference of opinion concerning the rule thus recently stated in the House of Lords:

> "When the facts are brought to his attention and when the facts are established in a Court of

justice for him to continue to do that which perhaps he was previously doing unintentionally or unconsciously before the matter was brought to his attention constitutes and is a fraud" (Edge vs. Gallon, 17 R. P. C., 557).

See, also,

Saxlehner vs. Siegel Cooper, 179 U. S., 42, and cases cited;

Reddaway vs. Banhan, A. C., 1896, 200, and cases cited;

North Cheshire, &c., Co. vs. Manchester, &c., Co., A. C. 1899, 83.

If for the sake of the argument it be admitted that Schultz when he appropriated the name of the famous springs was chiefly concerned with promoting the welfare of his patrons, the fact remains that he deliberately acted in a way which was to the detriment of his neighbor and in a manner that was in law unjustifiable. He in effect appropriated the property of the French Republic and the Court would have restrained him and restored that property however inadvertently or innocently he might have done it (See North Cheshire, etc., Co. vs. Manchester, etc., *supra.)* In contemplation of law his acts have been at all times fraudulent.

The controlling fact in connection with Schultz's use of the word is that until after suit was commenced against him his labels in no way disclosed, no matter how attentively examined, that his water was not drawn from the Vichy Springs.

His labels did not disclose or seek in any way to disclose that the water was not the natural water or that it was made or compounded by Schultz, and he not only represented his factitious water to be "Vichy," but he added to the injury by stating that it was "Grande Grille."

We submit that there could not be a better example of a technical trade-name than the word "Grande Grille." It is in a perfectly accurate, legal sense a technical trade-mark. It has a fixed, invariable definite and specific meaning denoting the origin and the property of the complainants to the exclusive use of which they are entitled.

The designation "Vichy Grande Grille" is analogous in its nature to such words as "Appollinaris," 33 L. T. N. S., 242; "Congress," 45 N. Y., 291; "Bethesda," 42 Wisc., 118, which have been held to be the property of the persons using them.

In Putnam Nail Co. vs. Bennett, 43 Fed., 800, Mr. Justice BRADLEY said:

> "Now a trade-mark clearly such, is in itself evidence, when wrongfully used by a third party, of an illegal act. It is of itself evidence that the party intended to defraud and to palm off his goods as another's.

This language is quoted with approval by this Court in Lawence Manfg. Co. v. Tennessee Manfg. Co., 138 U. S., 537, and is approved directly or indirectly in many other authoritative cases (Elgin Watch Co. vs. Illinois Watch Co., 179 U. S. 665; Reddaway vs. Banham, A. C. 1896, 199-210; Brown vs. Meyer, 139 U. S., 549).

The use by Schultz of the designation "Vichy Grande Grille" was in principle in every way the same as if the name of the French Republic or the Vichy Company had been used. It was we submit "a palpable and unmitigated fraud which admits of no possible justification."

Schultz's first label which was devised when he began the business prior to the year 1865 (Rec., p.

438), and was not changed until after suit against him was instituted (Rec., p. 116) was as follows :

Carl Schultz's Vichy. (GRANDE GRILLE.)	BAUER PARTS IN 100:000		
Potassium Sulphate,	20,404	Ammonium Carbonate,	0,469
Sodium Sulphate,	11,771	Calcium Carbonate,	25,003
Sodium Phosphate,	0,422	Strontium Carbonate,	0,232
Sodium Chloride,	57,878	Magnesium Carbonate,	3,529
Sodium Bromide,	0,013	Iron and Manganese,	traces
Sodium Iodide,	0,003	Alumina,	0,078
Sodium Carbonate,	380,130	Silicic Acid,	6,406

After suit was instituted he changed his labels by adding the following :

Carl H. Schultz's Vichy.	COMPOUNDED AFTER BAUER'S ANALYSIS		
Pottassium Sulphate,	20.404	Ammonium Carbonate,	0.469
Sodium Sulphate,	11.171	Calcium Carbonate,	25.003
Sodium Phosphate,	0.422	Strontium Carbonate,	0.232
Sodium Chloride,	57.878	Magnesium Carbonate,	3.529
Sodium Bromide,	0.013	Iron and Manganese,	traces
Sodium Iodide,	0.003	Alumina,	0.078
Sodium Carbonate,	380.130	Silicic Acid,	6.406

Thus in his new label the words " Manufactured By " are set in very small type being used in lieu of the name " Grande Grille " which in the first label was in comparatively conspicuous type.

Why did he insist upon having " Manufactured By " in type so small that it would not be likely to be observed ?

At the time the " Grande Grille " label was abandoned the defendant's solicitors wrote as follows :

> " In fact Mr. Schultz has already changed his labels to this form, and he would also be willing,

> if your clients should desire this, to print the word 'Artifical' in the left-hand corner of the upper label in type corresponding to the words 'Manufactured By' on the right-hand side."

Why did they insist upon having the word "Artificial" in type so small that no one could be likely to see it?

It is indisputably true that after their attention had been called to the matter they desired to use labels which concealed the fact that their water was "Manufactured By" or that it was "Artificial."

And we submit that it is an irresistible conclusion from their acts and suggestions that the "Grande Grille" label which they had used for years did not make the semblance of an attempt "clearly and unmistakably" (163 U. S. 204) to disclose that the water was an artificial product.

If it is suggested that the name "Carl H. Schultz" formed a conspicuous part of the label which was used until suit was instituted, we answer in the language of Croft vs. Day, 7 Beav., 84, a leading case which has been constantly cited with approval for more than half a century:

> "To have a copy of the thing would not do for though it might mislead the public in one respect it would lead them back to the place where they were to get the genuine article, an imitation of which is improperly sought to be sold. For the accomplishment of such a fraud it is necessary in the first instance to mislead the public, and in the next place to secure a benefit to the party practising the deception by preserving his own individuality."

And this Court has said:

> "It is no answer * * * to say that there was no invasion of that right because the name of S. O. Ryder accompanied the brand upon the flour sold by the appellants instead of the name of Holt & Co. That is an aggravation and not a justification" (Menendez vs. Holt, 128 U. S., 521).

Say the Court of Appeals for the Eight Circuit:

> "The only effect of placing their unfamiliar names and residences upon the packages * * * under the names of the appellee's well-known articles was to give the appellants the benefit of established reputation of the appellees' articles, and thus to enable them to derive greater benefit from their fraud" (Shaver vs. Heller & Merz Co., 108 Fed., 821–833).

Schultz began the use of the name "Vichy" for the purpose of taking advantage of the reputation of the complainants' springs. Until after suit was instituted against him he offered and sold his product as "Vichy Grande Grille," thus making use of a name used only in connection with the complainants' springs and never as a descriptive term. He began by saying of his product, "This is the water of the Grande Grille Spring, and it is Vichy." He continued to make that statement until after suit was brought against him. His thirty years' use of his label was thirty years of fraud.

Taking the narrowest possible view of the complainants' rights, the business carried on by Schultz until after suit was instituted by means of his first label was a fraudulent business based upon the use of fraudulent labels, in connection with which he acquired no rights of any description.

All these uses of the word "Vichy" are accurately described in the testimony of defendant's witness Casebeer, whose experience antedates the introduction of the Schultz Waters (Rec., p. 372).

> "85 x-Q. Don't you believe that these manufacturers of this artificial carbonated water in adopting the term 'Vichy' intended to imitate something?
>
> "A. They intended to imitate the Vichy Spring.
>
> "86 x-Q. And by using the name 'Vichy' they intended to borrow the reputation of the 'Vichy Water,' did they not?
>
> "A. Certainly" (Rec., p. 379).

In 1862, when Schultz began the sale of his water, his use of the word "Vichy" was fraudulent, and would have been restrained without hesitation by this Court.

His business had its origin in fraud, was inaugurated and carried on by the use of labels which never ceased to be fraudulent.

The other uses upon factitious waters have been comparatively of slight importance. If the use by Schultz is insufficient to support the defendant's argument, the other instances fall of their own weight.

The original and true meaning of the word "Vichy" has never been destroyed.

Under the common law, if the defendant had established that the original meaning of the word "Vichy" in the United States had been destroyed, while there would be no justification of the labels enjoined by the Court below there might be a justification of the use of the designation "Saratoga Vichy."

But proof that a word has been incorrectly or arbi-

tearily used is not proof that its true meaning has been destroyed.

In the present instance it is demonstrated to a certainty that the true meaning of the word "Vichy" in the United States has always been recognized and that it has not by an inaccurate and irresponsible use been destroyed or even materially impaired. The evidence as to the true meaning of the word "Vichy" in the United States and that it means to-day what it meant before any of the factitious or compound waters or the water of the defendant came into the market is contained abundantly in the record of the case against Schultz.

The use by Schultz is by far the most important instance of adverse use which is produced. For years Schultz referred in his book to "real Vichy" (Rec., p. 199).

Upon all his labels he displayed an analysis of one of the complainant's springs.

It may be remarked in passing that the analysis of all the springs are substantially the same, the differences between them being of inconsiderable importance (Rec., pp. 203, 134, 144, 401).

This is saying as formally and pointedly as possible that the word "Vichy" means a water containing the ingredients of "Vichy." And it is saying that no water is "Vichy" which does not contain those ingredients.

In an advertisement published by Schulz in 1891, he refers to his "Vichy" and "Vichy with Lithia," and says they were "analyzed by the principal professor of chemistry in 1862, and endorsed as * * * of *correct composition*, prescribed by the medical profession, used by over three hundred physicians and their

families," and that they are "the only * * * *correct* mineral waters sold in New York City to-day." (Rec., p. 233).

In the publication which Schultz put out and copyrighted in 1891, and which is offered in evidence in the Schultz case as "Defendant's Exhibit No. 39," and also as "Complainant's Exhibit, Schultz Publication" (Rec., p. 210), thousands of copies of which he circulated continuously (Rec., p. 353), he says: "Vichy * * * is the great alkaline water, carbonate of soda being its predominant ingredient." Then he refers to "Vichy Grande Grille," and gives the principal ingredients of the spring, and then he says that "Saratoga Vichy," so-called, differs "from real Vichy," and repeats in substance that "most people are misled by the name" (Rec., p. 226).

The defendant, on the other hand, has for years been asserting exactly the contrary. Schultz says in substance that the defendant's water is not "Vichy," because it does not contain the true components of the Vichy Springs. The defendant insists that the artificial waters are to be avoided, because "no natural mineral water can be exactly reproduced artificially except by accident," and since the beginning has continuously asserted that its water "takes special rank at once * * * from its wonderful similarity to the Vichy waters of France." This statement, with the exception of the word "wonderful," which was omitted about the year 1880, has been repeated in all the circulars put out by the defendant, and with it have been used the following, among other similar statements:

> "Do not fail to ask for the Saratoga Vichy, as all other Vichy drawn from mineral fountains and in many cases the bottled Vichy is a manu-

factured water in imitation of the French Vichy, and should not be confounded with the Saratoga Vichy, which is a pure natural Vichy" (Rec., p. 53).

"The Saratoga Vichy is an excellent table water and superior to the French Vichy, as it contains more natural carbonic acid gas" (Rec., p. 53).

For years they used on their label (Rec., pp. 13, 33), to supplement the word "Natural," the following statements:

"A medicinal beverage bottled with the natural gas of the spring only."

"I cannot condemn in too strong terms the use of artificial mineral waters. They never replace those of the natural spring."

"No natural mineral water can be exactly reproduced artificially except by accident" (Rec., p. 33).

On their last circulars they have repeated in prominent type the caution which they have used continuously and in many ways from the first:

"BEWARE OF ARTIFICIAL VICHY" (Rec., pp. 39, 69, 71).

In every way the defendant has offered and sold its product as "Natural" and as "Pure Natural Vichy." The defendant in its circulars has continuously said that its water is "just as good as the imported Vichy" (Rec., p. 37), "superior to the French Vichy" (*Ib.*, pp. 53, 59, 61, 69, 71), of "equal merit with the celebrated French Vichy" (*Ib.*, p. 83), "its similarity to the Vichy waters of France" (*Ib.*, pp. 59, 61, 69, 71, 75, 99).

The price-lists of Schieffelin & Co. of New

York, and Wyeth & Bro. of Philadelphia, leading houses in the trade, published one in 1889 and the other in 1898, referred to complainants' product as "the genuine Vichy Water" (Rec., p. 238), and the testimony is that "other houses of established reputation" use and have used the expression "genuine Vichy Water" in the same way (*Ib.*, p. 238).

We do not suggest that the original meaning of a word or symbol may not be effectually displaced and destroyed by continued use in a secondary sense. The language is recruited in this way, and in some instances the right of the public began with unmistakable fraud and misrepresentation. "Epsom Salts" (71 Fed., 169), "Hunyadi Water" (179 U. S., 19), are examples of this kind.

But we submit that there is a perfectly safe and infallible test which is clearly illustrated by the case before us.

So long as the word "genuine" has value to differentiate the complainants' article from the defendant's the use of the word or symbol by the defendant in a false relation is misleading and fraudulent. This record shows that to use the expression "Genuine Vichy" is to refer to the waters of the Vichy springs. The inevitable conclusion is that water from any other source is NOT "GENUINE Vichy." In other words, it is SPURIOUS "Vichy." There is fraud and a right of action.

In this case the defendant has not shown that the word "genuine" is without value to point out the complainants' product, and its defense is not good.

It is thus shown that what we conceive to be the true meaning of the word "Vichy" has been preserved

and perpetuated, and that it means a product which is distinctly unique.

We submit that "Vichy" is in every way substantially the same as "Carlsbad" (71 Fed., 168), "Akron" (51 N. Y., 189), "Radstock" (Braham vs. Beachin, 7 Ch. D., 848), "Leopoldshall Kainit" (L. R., 14; Eq., 348), "Jarrahdale Jarrah" (73 L. T. R., 80), "Seixo" (L. R. Ch., 192; 13 Wall., 315), and other words which have denoted a unique product of nature founded only at a particular place, and which have been held to be in the nature of trade-names.

We respectfully suggest, too, that the cases which protect such geographical names as "Waltham" (53 N. E., 141), "Glenfield" (138 U. S., 550; 179 U. S., 683), "Stone" *(Ib.)*, "American" (108 Fed., 821), "Chicago" (83 Fed., 213), "Minneapolis" (86 Fed., 608; 88 Fed., 645), add certainty to the long recognized rule as to names which denote natural products which are unique and found only at particular places.

Unless, therefore, the defense, based upon the complainant's delay, is good, the decision of the Court below should be corrected by granting full relief. We submit that the case is the same as if action had been taken when the first bottle of spurious "Vichy" appeared for four reasons, which we proceed to consider.

THE LAW.

The fact that the French Republic is the principal complainant renders the defense of laches valueless and inapplicable.

Upon the broad ground that the principal complainant is a sovereign power we respectfully contend that the defense of laches should go for nothing, and especially in view of the nature of the acts of the defendant.

The answer alleges that there is a misjoinder of parties plaintiff because "the said plaintiff 'La Republique Francaise' has no interest in the matter alleged in the said bill of complaint" (Rec., p. 113). That the French Government is a necessary party and is materially interested in the subject matter of the suit, the ownership of the springs, and the name appurtenant thereto is plain, we think, without argument, and is demonstrated by many cases.

The case is the same as if the French Government were a patentee and the Vichy Company the exclusive licensee, and in such a case there is no question that the owner of the patent would be an indispensable party.

Waterman vs. Mackensie, 138 U. S., 252.
Birdsell vs. Shaliol, 112 U. S., 485.
Paper Box Cases, 105 U. S., 766.
Otis Bros. Mfg. Co. vs. Crane Rros. Mfg. Co., 27 Fed., 550.
Story's Eq. Pl., § 72; quoted and approved in Gregory vs. Stetson, 133 U. S., 579.
Foster's Fed. Prac., Vol. 1, § 42, p. 110.
Chadbourne's Executors vs. Coe, 10 U. S. App., 78.
Williams vs. Bankhead, 19 Wall., 563.

The case of Kernochan vs. New York Elevated Railway Co., 128 N. Y., 550, relied on by the defendant's counsel in the Court below, related only to the recovery of damages arising from interference with plaintiff's easement by defendant's road. If an injunction had been applied for the owner of the premises would certainly have been a necessary party, and the Court does not intimate the contrary.

In the present instance the purpose of the suit being the protection of the property by injunctive relief, the owner of that property is an indispensable and, perhaps, the only necessary party.

It is certain that if the Government of the United States were a complainant in this case, as the Government of France is a complainant, there could be no imputation of laches.

United States vs. Kirkpatrick, 9 Wheat. 720.
Dox vs. The Postmaster-General, 1 Peter, 318.
United States vs. Knight, 14 Peters, 301.
Gibbons vs. Unifed States, 8 Wall., 269.
Gibbons vs. Chouteau, 13 Wall., 92.
People vs. Gilbert, 18 Johnson's Reports, 229.
Steele vs. United States, 113 U. S., 128.
United States vs. Nashville, &c., D'y Co., 118 U. S., 120.
United States vs. Beebe, 127 U. S., 338.
United States vs. Insley, 130 U. S., 263.
San Pedro, &c., Company vs. United States, 146 U. S., 120.

In the United States vs. Thompson, 98 U. S., p. 486–489, the rule is summarized as follows:

"The rule of *nullum tempus occurit regi* has existed as an element of the English law from a very early period. It is discussed in Bracton, and has come down to the present time. It is not necessary to advert to the qualifications which successive parliaments have applied to it.

"The common law fixed no time as to the bringing of actions. Limitations derive their authority from statutes. The king was held never to be included, unless expressly named. No laches were imputable to him. These exemptions were founded upon cosiderations of public policy. It was deemed important that, while the sovereign was engrossed by the cares and duties of his office, the public should not suffer by the negligence of his servants. 'In a representative government, where the people do not and cannot act in a body, where their power is delegated to others, and must of necessity be exercised by them, if exercised at all, the reason for applying these principles is equally cogent.'

"When the colonies achieved their independence, each one took these prerogatives, which had belonged to the crown; and when the national Constitution was adopted, they were imparted to the new government as incidents of the sovereignty thus created. It is an exception equally applicable to all governments. United States v. Hoar, *supra;* The People v. Gilbert, 18 Johns. (N. Y.) 227; Bac. Abr., tit. Limitation of Actions; *ib.*, tit. Prerog. E. 5, 6, 7; 5 Com. Dig. Parliament, R. S., Chitty, Law of Prerogatives, 379."

And the reason why laches is not imputable to the sovereign has been stated over and over again.

In United States vs. Kirkpatrick, 9 Wheat., 720, the Court said:

"Then as to the point of laches, we are of opinion that the charge of the court below, which

supposes that laches will discharge the bond, cannot be maintained as law. The general principle is that laches is not imputable to the government; and this maxim is founded, NOT IN THE NOTION OF EXTRAORDINARY PREROGATIVES, but upon a great public policy. The government can transact its business only through its agents; and its fiscal operations are so various, and its agencies so numerous and scattered, that the utmost vigilance would not save the public from the most serious losses, if the doctrine of laches can be applied to its transactions. It would, in effect, work, a repeal of all its securities."

In United States vs. Knight (14 Pet., 311) the Court said:

"The same principle has been decided in New York, Massachusetts, Pennsylvania, and no doubt in other states; and all upon the same ground. Not upon any notion of prerogative; for even in England, where the doctrine is stated under the head of prerogative, this in effect means nothing more than that this exception is made from the statute, for public good; and the king represents the nation. The real ground is a great principle of public policy, which belongs to all governments, that THE PUBLIC INTEREST SHOULD NOT BE PREJUDICED BY THE NEGLIGENCE OF PUBLIC OFFICERS to whose care they are confided."

This explanation of the doctrine has been many times repeated by this Court:

United States vs. Van Zandt, 11 Wheat., 184.
Dox vs. The Postmaster-General, 1 Pet., 318.
Lindsey vs. Miller's Lessee, 6 Pet., 666.
Gaussen vs. United States, 97 U. S., 584.
United States vs. Nashville, &c. Ry. Co., 118 U. S., 120.

All of the decisions of the Court concur in giving the same reason why laches cannot be imputed to the government which is, in brief, that the public interests should not be permitted to suffer by reason of the negligence or inattention of individuals who may fail in the discharge of their duties.

For the same sufficient reason we submit that laches will not be imputed to a foreign sovereign or government.

We regret to say that very diligent search has failed to bring to light any authorities which directly and in terms support this contention.

Perhaps some light is shed upon the question by the case of Vavasseur vs. Krupp (R. L. 1878, Ch. D. 9, 351) and by the rule as to laches applied in international relations (Wharton Int. Law Dig., 2d Ed., vol. 2, § 239), and if so, they support our contention.

But we think that it must be apparent that the reasons which make the rule good with respect to the Government of the United States make it good to include the Government of France.

The equities in each case are exactly the same. In the instance before us the defendant's contention is that the people of France should be made to suffer for the inattention of the public officials of France. The French people are innocent in the premises and it would be inequitable to punish them for exactly the same reasons that it would be inequitable to punish the people of the United States if the United States were a complainant.

And there is no doubt that in the courts of the United States, in this class of cases, except as the broad and perfect rule has been disturbed by treaties, and excluding a few unimportant subjects, an alien has

quite the same recognition as a citizen of the United States. The jurisdiction includes all men of all nations. In the absence of special conditions, it would be the height of folly for a citizen of the United States to say in this Court that he belonged to a favored class.

If the citizens of France came as individuals into this court of the United States and demanded equity, their case would be heard without regard to their citizenship. There would be no discrimination against them because they were foreigners. We submit that there will be no discrimination against their government.

We think that the decisions of this Court leave no possible doubt as to the existence of the rule and the reasons upon which it is based.

The question to be answered is a very simple one: Are the reasons which are good to preclude the imputation of laches in a suit by the United States of value in a suit by the government of France?

To the last detail and in every particular the reasons are obviously the same.

In the light of the authoritative decisions we have cited, we most humbly and respectfully submit that to ask the question is to answer it.

And in the concrete case before us there would seem to be specific reasons why it is impossible to hold that the Government of France and the people of France acquiesced in the things which are imputed to them.

The effect of the acts of the defendant and the class it represents has been, it may be said, to render impossible the sale of genuine Vichy in the United States.

The water of the defendant and the factitious waters produced at inconsiderable expense, paying nothing in duties or for transportation, are sold as "Vichy," and necessarily stand in the way of and preclude the importation and sale of the water of the Vichy Spring. It thus appears that the argument for the defendant is that the right of the Republic of France to sell its product in the United States has been lost or destroyed.

Certainly a court of equity representing the Government of the United States should hesitate to say that this right to import and sell has been destroyed, and particularly when the only justification is a usage which is uncertain, unreasonable and immoral.

And it is to be observed that the irresponsible use of the name "Vichy" in connection with the water drawn from soda fountains and the like, is distinctly different from the use of the word by the defendant and the class it represents. The use of the name to describe a water drawn from a soda fountain does not necessarily stand in the way of the importation and sale of complainants' goods. If there is competition it is very different from that which arises where the water is sold, as defendant sells it, in packages which in every way take the place and prevent the sale of the packages of the complainants.

We submit that the Republic of France may invoke the application of the same rule as would be applied if the United States were a party and that the charge of laches or acquiescence may be dismissed from consideration as valueless and immaterial.

The Irresponsible and Untruthful Usage of the Name "Vichy" Constitutes no Defense.

We submit that all the testimony offered by the defendant from first to last which tended to show an untruthful and misleading use of the word "Vichy" was incompetent and that it should not be considered by a Court of Equity.

We say that, in contemplation of law, the case is the same as if no testimony had been offered tending to show the use by the public of the word "Vichy" to indicate a water not drawn from the Vichy Springs.

This proposition is a sound and wholesome one, because the evidence tends only to show a custom, and there can be no proof of a custom unless the usage is reasonable, certain and moral. It is particularly applicable in cases of this character. Piracy exists just as larceny exists. To impose upon the successful producer the duty of pursuing every pirate who crosses his path, or, what is the same thing, to allow proof of irresponsible and fraudulent uses of marks of origin to be set up as a defense to an action to terminate piracy is to defeat the objects which the law is designed to accomplish.

It is elementary law that a custom or usage to be recognized must be reasonable, certain and moral.

United States vs. Buchanan, 8 How. (U. S.), 83, 102.

Tilley vs. County of Cook, 103 U. S., 155, 163.

Allen vs. St. Louis Bank, 120 U. S., 20, 39.

Vaughan vs. Holden, Cro. Jac., 80.

Taylor vs. Carpenter, 2 Wood. & M., 1, and cases cited.

Broad Bent vs. Wilkes, Willes, 360, 5 Q. B., 701.

Codman vs. Evans, 5 Allen (Mass.), 308; 82 Am. Dec., 258.

In "The case of Tanistry" (the custom by which land descended to the oldest and most worthy man of the blood and surname) there is an invaluable statement of the rule:

> "Where the people find an act to be good and beneficial, and apt and agreeable to their nature and disposition, they use and practice it from time to time, and so by frequent iteration and repetition of the act a custom is formed, and being used time out of mind it obtains the force of law. And so the Rule 44, Ed. 3, 19, is true, that no law binds the people only that which is made by consent of the people; for consent may be expressed as well by deed as by word, and that which is expressed by deed is stronger than that which is expressed by word; and that which is expressed by several and continual acts of the same kind is a custom; and so, briefly, custom is a reasonable act, reiterated, multiplied and continued by the people time out of mind. And this is the definition of custom which hath the virtue and force of a law.
>
> "Secondly, it was said that such custom ought to have four inseparable qualities: 1. It ought to have a reasonable commencement. 2. It ought to be certain and not ambiguous. 3. It ought to have an uninterrupted continuance time out of mind. 4. It ought to be submitted to the perrogative of the King, and not exalted above it.
>
> "1. The commencement of a custom (for every custom hath a commencement, altho' the memory of man doth not extend to it, as the river Nile hath a spring, altho' geographers cannot find it)

> ought to be upon reasonable ground and cause. For if it was unreasonable, no usage or continuance can make it good. *Quod ab initio non valuit, tractu temporis non convalescet.*"
>
> Davies' Rps., p. 78–87.

For centuries there has been no departure from the rule which is here laid down.

> "That cannot be called a custom which is grounded upon fraud" (Viner's Abridgment. Customs (H), 24).

In the instance before us the custom, so-called, is "grounded upon fraud."

The uses of the word "Vichy" in connection with the trade-mark "Grande Grille" by Schultz and others, and its use upon waters bearing no, or at most, a remote resemblance to the waters of the Vichy Springs were at first unmistably misleading and fraudulent. The uses continued for many years have not changed in character. The custom of using the word has no foundation in law for it is "grounded upon fraud."

Nor has the usage of the word "Vichy" been certain. It has been used in the United States to sell waters which have been broadly unlike each other (Rec., pp. 373, 374). The thereapeutic effects of the various waters which have been sold under the name have differed radically. Schultz contended that his Vichy was the only "correct composition" (Rec., p. 209).

The proof offered by the defendant shows that the word "Vichy" has been used recklessly and adventurously to describe any water charged with

carbonic acid gas, and to sell it as "Vichy," and that the word has had no certain and definite meaning except in connection with the waters of the Vichy Springs.

It follows that the word "Vichy" has not been impressed with any meaning by the public and indiscriminate use offered in evidence, and that the custom which such evidence tends to establish can have no foundation because it is not in any sense certain.

And the custom which this usage tends to establish has no foundation in law for it is not moral.

In Taylor vs. Carpenter, 2 Wood & M., 1, there was an action on the law side for deceit in using plaintiff's trade-mark on defendant's goods and selling them as and for plaintiff's goods.

In the course of the trial defendant offered to prove a general custom commonly observed in the United States, England, Germany and France for the last twenty years to use and imitate marks of foreigners, and that such custom was generally known in the commercial world and not contrary to the laws of such countries.

The evidence was excluded and the Court, speaking by Mr. Justice WOODBURY, said :

> "I am not aware of any principle, by which a a usage in this or a foreign country is competent evidence in defense of a wrong. * * * There is something very abhorrent in allowing such a defense to a wrong, which consists in counterfeiting other's marks or stamps, defrauding others of what had been gained by their industry and skill, and robbing them of the fruits of their 'good name' merely because they have shown forbearance and kindness.

"A custom ought to be, at least, moral and reasonable in order to be upheld.
Bacon's Abr. 'Custom' C.

"A party can hardly set up his own bad conduct or character in defense to an action, nor justify them because they may not have been materially worse than those of some other persons (15 Pick., 506).

"It is rather an aggravation to the plaintiffs, that many others have injured them as well as the defendants; and it is only an argument *ad hominen* to them that in England an alien in a case like this cannct recover (if such be the usage and law), but cannot affect our own sense here of what is moral toward others, and what is due to our self-respect in punishing frauds, and what seems to be demanded from us both by justice and law, however others may conduct in like cases."

The testimony thus rejected by the Court differed from that which has been produced in the case at bar in degree, perhaps, but not in kind. The name "Vichy" was adopted and used by the defendant and the class it represents because "Vichy" had a reputation and was known, and because it was hoped to profit by the existence of that reputation. The proof offered of the loose, inaccurate and irresponsible use of the word in connection with all kinds of water was proof of the fraudulent use of the name "Vichy Springs," no more and no less. This is obvious on the face of the evidence, and is directly admitted by many of the witnesses (Rec., pp 320, 322, 325, 332, 336, 365, 273, 378).

Unless a name of origin has wholly lost its meaning, unless the word "genuine" is without value to differentiate the original article from others bearing the

name, proof of its use by others is simply proof of a fraudulent usage. And this, we submit, may be said to be one sufficient reason for the many authoritative cases which discourage a recognition of laches in cases relating to commercial reputation and good-will.

McLean vs. Fleming, 96 U. S., 258, and cases cited *infra*.

Evidence of an immoral, uncertain and unreasonable usage or custom is not admissible, and we submit that the custom or usage in the present instance is uncertain, unreasonable and immoral, and that all the evidence offered by the defendant to prove it should be laid out of sight.

Mere laches in a case of this character does not defeat the right to injunctive relief.

It has been stated that a knowledge of the use in the United States of the word "Vichy" by the defendant and others was not brought home to the complainants. They had protected their exclusive right to the designation "Vichy" in the courts of France and had been in the exclusive enjoyment and possession of that name in France from time immemorial.

But if it was their duty to inform themselves as to what was being done elsewhere, and there is a constructive acquiescence covering a period of a quarter of a century or more, we submit that that fact is of secondary importance.

If the complainants are estopped it is by reason of "inexcusable laches in seeking redress." That is the very reason why they are concluded.

The subject of laches in cases of this kind has been heard and considered on several occasions and quite recently by this Court and we hesitate to do more than call attention to the facts of the case before us.

But the subject is very important and the rule applied by the Court of Appeals for the Second Circuit in this case is, we think, in conflict with the rule announced by the Court of Appeals for the Third Circuit in Actiengesellschaft, &c., vs. Amberg (109 Fed., 151), wherein the rule is said to be that delay in bringing suit in a case of this character does not impair the right to relief against further injury unless there is also an abandonment. Both decisions were rendered after the decision of this Court in the case of Sax-

lehner vs. Eisner and Mendelson Co. (179 U. S., 19), and the rule as to laches in cases of this character is one the application of which is frequently demanded. We, therefore, beg to be permitted to lay before the Court our view of the law.

But three defenses can be suggested: (**1**) that there has been acquiescence whereby a license has been created, (**2**) that there is abandonment, (**3**) that a court of equity will not aid the delinquent suitor but will compel him to seek his remedy in a court of law. There is no other possible suggestion.

To examine these propositions is to demonstrate that in the case before us the rule illustrated by McLean vs. Fleming should be applied and the complainants disciplined by losing an accounting of profits without rewarding the trespasser for persistent misrepresentation.

1. Acquiescence, however long continued, cannot create a license.

Unless there is a conveyance of good-will the owner of a mark of origin cannot by acquiescence, or in any other way license or alienate the right to the use of his mark. Nor can a court of equity actually or constructively make a license for him. This is true because a mark of origin is a definite guarantee and statement that the product to which it gives individuality comes from a particular source. A cannot empower B to represent that the goods made by B are made by A. The owners of the Vichy Springs cannot empower the defendant to represent that Saratoga water was dipped from the springs in France. A license to lie has no fountation in reason or the law.

All the cases which touch the subject support this

very obvious proposition (Kidd vs. Johnson, 100 U. S., 617; Morgan vs. Rogers, 19 Fed, 596; Pinto vs. Badman 8 R. P. C., 181; Witthaus vs. Braun, 44 Md., 303).

If the owner of the mark and the Courts have no power to make acquiescence equivalent to a license it is plain that the rule which is applied in cases where a license can be made is without force or application.

Thus in the case of a patent or an easement of any kind if there is long continued acquiescence in an adverse use, the Court having power to do so holds the party who has assented and continued to assent to the natural, reasonable and necessary consequences of his acts, and interprets them to be of the same significance as a written instrument.

But to start with the immovable fact that there can be no license and no written instrument is to render impossible any consideration much less any application of the rule.

In the case of Saxlehner vs. Eisner & Mendelson (179 U. S., 19) we understand that the rule for which we contend was applied and proved by an exception. It was there held that the long-continued user by others of the complainant's trade-mark "Hunyadi," and the complainant's label upon a well-defined class of medicinal waters precluded relief as to the name but not as to the label. The facts relating to the trade-mark and those relating to the label differed in nothing which was considered essential but this: "The infringers were making use of their trade-marks (consisting in part of the word 'Hunyadi') under license from the Hungarian government" (p. 36), whereas there was "no decision of the Hungarian authorities authorizing the use of Saxlehner's label by other parties" (p. 38).

In that branch of the case relating to the labels the rule was applicable that long-continued acquiescence —even a decision refusing relief against infringement (p, 27)—could not create a license because a license to lie is impossible in the law.

But in that branch of the case relating to the word "Hunyadi" the Court found that there actually was "as a matter of fact" (p. 36) an express license to others to use the name created twenty years before by the Hungarian Minister, and held, in substance, that the complainant, after twenty years, would not be heard to question the validity of that license.

Unlike the case of the labels, the case of McLean vs. Fleming, and the case at bar, there was no difficulty in alienating or licensing the right to use the name "Hunyadi," because the license created by the Hungarian Minister, "as a matter of fact," existed.

The "Hunyadi" case differs from the case at bar in many respects. The adverse uses of the name "Hunyadi" (in itself a meaningless word) upon a well-defined class of bitter waters in a way tending to destroy the meaning given it by the original user had operated to make the word a part of the language as indicating that particular class of waters, whereas the adverse uses of the name "Vichy" (in itself a name of origin for centuries) upon waters broadly unlike each other in a way to keep alive by reference its true meaning have not operated to impress on the word any new meaning or even seriously to impair its original meaning as indicating the waters of the Vichy Springs. In other words, the cases differ in that in the "Hunyadi" case but not in the case at bar the delay was "continued so long and under such circumstances as to defeat the right itself" (128 U. S., 514;

179 U. S., 39). The cases also differ in that the name "Vichy," unlike the name "Hunyadi" but like the labels in "Hunyadi" casewas "seized upon * * * without a shadow of justification and in fraud of plaintiff's rights" (179 U. S. 37), and in many other particulars.

But we think that the "Hunyadi" case supports our contention because in so far as it relates to the name "Hunyadi" it effectually proves the rule which was in substance applied to that branch of it which concerned the labels, that acquiescence, no mater how long continued, cannot create a license.

2. That a trade-mark may be abandoned is not less certain than that the right to use it cannot be made the subject of a license, and if the Court finds that there has been abandonment by reason of acquiescence, or for any other reason, there is no remedy. In brief, in every case the question is whether the facts show an acquiescence without abandonment, or abandonment pure and simple.

If there is acquiescence without abandonment as the original right still exists and there can be no license the acts of the trespasser with respect to which there has been acquiescence are justified and the delinquent suitor is denied all compensation for the use of his mark and reputation, and the rule of McLean vs. Fleming, is applied.

If there is an abandonment there is no trade-mark, and the bill is dismissed because there is no right of action. If there has been an abandonment by reason of acquiescence, or for any other reason there is no remedy.

Our understanding is that because the right of

property in a trade-mark or good-will is unique, the rule with respect to laches or acquiescence is unique as laid down by this Court, and in many other cases to some of which we direct attention.

Say the Court in a case in which the rule was laid down more than twenty years ago :

> " Acquiescence of long standing is proved in this case and inexcusable laches in seeking redress. * * * But infringement having been proven * * * the injunction was properly ordered " (McLean vs. Fleming, 96 U. S., 258).

This language is not mere dictum. The Court took particular pains to recite the facts of the case, and said :

> " Repetition of the facts is unnecessary, as it sufficiently appears that the respondent has been engaged in preparing and selling his pills for more than forty years ; that during that period, or more than half of it, he has been using labels and trade-marks corresponding more or less to those used by the predecessors of the complainant, some of whom, during all or most of that time, knew what the labels and trade-marks were which were used by the respondent, the evidence to that effect being full and decisive.
>
> " Negotiations took place at one time between the respondent and one of the predecessors of the complainant for an interchange of commodities, with a view that both commodities might be sold at each of their respective places of business.
>
> " Evidence of a decisive character is exhibited in the record to show that the complainant or his predecessor knew throughout what description of labels and trade-marks the respondent was using ; and it does not appear that any objection was ever made, except as heretofore stated and explained.

> Once, the respondent was requested to insert the initials of his Christian name before his surname, in the label; and it appears that he immediately complied with the request" (257).

In Menendez vs. Holt, where there had been an acquiescence of eleven years with full knowledge and without protest, the Court said:

> "Counsel in conclusion earnestly contends that whatever rights appellees may have had were lost by laches; and the desire is intimated that we should reconsider McLean v. Fleming, 96 U. S., 245, so far as it was therein stated that even though a complainant were guilty of such delay in seeking relief upon infringement as to preclude him from obtaining an account of gains and profits, yet, if he were otherwise so entitled, an injunction against future infringement might properly be awarded. We see no reason to modify this general proposition, and we do not find in the facts as disclosed by the record before us anything to justify us in treating this case as an exception" (128 U. S., 523).

In Lawrence Man. Co. vs. Tenn. Man. Co., 138 U. S., 549, the rule is referred to and approved and it is pointedly applied in Brown Chemical Co. vs. Meyer, 139 *Ib.*, 546.

In the still more recent case of Singer Man. Co. vs. June Man. Co., 163 U. S., 186, 202, the rule of the earlier cases is approved and applied.

As we have pointed out, we do not understand that in the case of Saxlehner vs. Eisner & Mendelsohn Co., the rule was sought to be in any degree modified.

Referring to an acquiescence of twenty years (102 Fed., 551), in a very general use of the *indicia* involved the Court of Appeals for the Third Circuit say:

"It is no answer to his complaint against any particular person who has so used it to say that such person is not the only one who has done so, for a trespasser cannot justify upon the ground that others have committed like trespasses. Therefore the appropriation by the appellee of the appellant's box and labels is not excused by showing merely that others had similarly appropriated them. It is essential that it should also appear that the appellant had, by its acquiescence, abandoned its exclusive right, and, 'to establish a defense of abandonment, it is necessary to show, not only acts indicating a practical abandonment, but an actual attempt to abandon.' Saxlehner v. Eisner & Mendelson Co., 179 U. S., 19, 21 Sup. Ct., 8, 45 L. Ed., 60" (Actiengesellschaftt, &c., v. Amberg, 109 Fed., 151).

In the recent and carefully-considered case of Bissel Chilled Plow Works vs. T. M. Bissel Co. (121 Fed Rep., 357, 375) there was a delay with knowledge of about six years. An attempt was made to take the case out of the rule by urging the absence of a fraudulent intent. An injunction was granted.

Rodgers vs. Philp (1 O. G., 29; Browne on Trade-Marks, 2nd Edition, p. 661): "These goods," said the Court, "have been manufactured in Germany * * * for nearly if not quite a quarter of a century." It appeared that complainant had notice (*Ib.*, p. 660). An injunction was granted (*Ib.*, p. 661).

Wolfe vs. Barnett: A delay of about ten years (24 La. Ann., 97). "Wolfe's Schnapps" was involved.

Filley vs. Fassett: A delay of about sixteen years (44 Mo., 173). "Charter Oak Stoves" was in issue.

Cohn vs. Gottschalk: A delay of five years (14 Daly, 542).

Manhattan Medicine Co. vs. Wood: The rule was recognized in referring to a delay of fourteen years (4 Cliff., 461).

Amoskeag Man. Co. vs. Garner: A delay of nine years (54 How. Pr., 298, reversing the court below). The geographical word "Amoskeag" was sustained.

Gillott vs. Esterbrook: There was notorious use of the numerals "303" for about fifteen years (47 Barb., 455; affirmed, 48 N. Y., 374).

Coleman vs. Crump: The defendant, a label printer, had been manufacturing and selling the infringing labels in many different styles which had been in use by the trade for about fifteen years (70 N. Y., 573).

Sanders vs. Jacobs: A delay of four years (20 Mo. App., 96).

The rule applied in these cases is referred to with approval in many others:

Amoskeag Man. Co. vs. Spear, 2 Sand, S. C., 599; 128 U. S., 524.

Consolidated Fruit Jar Co. vs. Thomas, Cox's Man., Case, 665.

Julian vs. Hoosier Drill Co., 75 Ind., 408; 128 U. S., 524.

Sawyer vs. Kellogg, 9 Fed., 601.

Williams vs. Adams, 8 Biss., 452.

Le Page Co. vs. Russia Cement Co., 51 Fed., 941.

In the present case there has been no abandonment and there is nothing in the case to support the contention that there has been, if any such contention is suggested on behalf of the defendant.

With the familiar doctrine before us that all the presumptions are against the defense of abandonment, the fact that the French Republic is a complainant,

grounds upon which courts of equity take jurisdiction s to protect the public against fraud and imposition.

Singer Manufacturing Co. vs. June Manfg. Co., 163 U. S., 200, 187.
Pillsbury vs. Pillsbury-Washburn Co., 64 Fed., 845.
Montgomery vs. Thompson, 1891 A. C., 217.
Pillsbury Co. vs. Eagle, 86 Fed., 608.

Manifestly, unless there can be injunctive relief, whereby the fictitious and misleading use of the trade-name or trade-mark can be prevented, one defendant may follow another, and there would be an "unrestrained right to deceive and defraud the public by so using the name as to delude them into believing that the machine made by one person was made by another" (163 U. S., 187).

It is obvious that this case is not one which should be sent to a court of law.

We most respectfully submit in the case before us (1) that the defendant cannot justify the continued use of our designation on the ground that a constructive license has been created by acquiescence, because there is no power to make a license; (2) that there has been no abandonment, and there can be no justification upon that ground; (3) that the Court will not require us to seek our remedy in a court of law, for there is no remedy except in this court.

The necessary and only possible conclusion is that the rule of McLean vs. Fleming, Menendez v. Holt, and of the Third Circuit, should be applied to the case and the complainants punished in reason, without rewarding the trespasser for persistent turpitude and misrepresentation by actually dividing the living child in two.

The right to protection guaranteed by the treaty with France may be invoked, notwithstanding the duration and extent of the infringements.

The bill of complaint alleges that the complainants "are entitled to be protected in the exclusive use of the word 'Vichy' as a trade-name and as a commercial name and otherwise, by virtue of the treaties at present existing and in force between the Republic of France and the United States, and particularly the treaty between the United States and France and other nations, concluded at Paris on the 20th day of March, 1883, and proclaimed by the President of the United States on the 11th day of June, 1887, the Eighth Article of which treaty is as follows, to wit:

"'ARTICLE VIII.

"'The commercial name shall be protected in all the countries of the Union without obligation of deposit, whether it forms part or not of a trade or commercial mark."

We respectfully submit that there could be no better illustration of the conditions which it is the purpose and function of this article of the treaty to correct than is afforded by the case at bar.

That "Vichy" is a commercial name ("nom commercial") requires no demonstration. It would be hard to find a better example of a "commercial name."

Opinion of Judge TOWNSEND, Rec., p. 244 *et seq.*, 57 Fed., 37.

Congress & Empire Spring Co. vs. Rock Congress Spring Co., 45 N. Y., 291.

Radde vs. Norman, L. R., 14 Eq., 348.
Ragget vs. Findlater, L. R., 17 Eq., 29.
Apollinaris Co. vs. Norrish, 33 L. T. R. N S., 242.
Dunbar vs. Glen, 42 Wisc., 118.
Anheuser-Busch Brewing Assn. vs. Piza, 23 Blatch., 244 ; 24 Fed., 149.
Lever Bros., Limited, vs. Pasfield, 88 Fed., 484.
City of Carlsbad vs. Kutnow, 71 Fed., 167.
Hill vs. Lockwood, 32 *Ib.*, 389, 395.

That the complainants enjoy in France to all intents and purposes the exclusive right to use the designation "Vichy" is equally clear.

Action by the legislative department of the government is not necessary in order that the protection guaranteed by the treaty may be invoked.

Saxlehner vs. Eisner & Mendelson, 179 U. S., 19.
United States vs. Rauscher, 119 U. S., 407, 418, and cases cited.

The purpose of the treaty is plainly set forth in the preamble, the averments of which are "to be regarded as truths admitted" (32 Me., 222):

> "Equally animated by the desire to assume, by common accord, A COMPLETE AND EFFICACIOUS PROTECTION to the industry and commerce of the subjects of their respective states, and to contribute to the safeguard of the rights of inventors, and to the loyalty of commercial transactions, have resolved to conclude a Convention to that effect" (U. S. St. at Large, Vol. 25, p. 1375).

The object of the treaty before us was to make sure of the enjoyment of foreign good-will and to eradicate fraud and misrepresentation.

Among the provisions inserted to accomplish this object is that relating to commercial names:

> "The commercial name shall be protected in all the countries of the union without obligation of deposit whether it forms part or not of the trade or commercial mark" (U. S. Stat. at Large, Vol. 25, p. 1376).

At the time this provision was ratified the complainants were, as they now are, the owners of the Vichy springs; their good-will, based upon their trade-name "Vichy," was, as it still is, of indisputable foundation, and was, as it still is, undisputed within the jurisdiction of France.

It is not less certain that many persons in the United States were using the word "Vichy" as the name of waters which were not genuine "Vichy" (Rec., p. 403). These persons obviously had acquired no rights of any description. They were, we submit, doing exactly what the treaty declares shall not be permitted.

It must be reasoned that the guaranty that "the commercial name shall be protected" contemplates that without such guaranty "the commercial name" is in danger of injury. It is equally plain that injury could result only from infringement or spoliation of the name. It is clear, therefore, that it is against infringement and spoliation that the provision is directed.

We submit that it provides for the "complete and efficacious" eradication and prevention of infringement and spoliation of foreign commercial names no matter when it began by which the enjoyment of an existing good-will is defeated.

Because of the circumstances of the case, if American waters may be called "Vichy" genuine "Vichy"

cannot be sold here and the complainants are despoiled of their name.

We say that as long as "Vichy" is our "commercial name" in France, by virtue of this treaty such spoliation is impossible. It is impossible to "protect" and at the same time permit spoliation.

It cannot be reasoned that the treaty which is the supreme law of the land can be defeated by proof that there has been a continuous, uncertain and unreasonable use which began in fraud of the name which it is guaranteed shall be protected.

The treaty cannot be read to say:

> "The commercial name shall be protected in all the countries of the union * * * provided it has not been or will not be infringed."

It cannot be said that the treaty shall be nullified because if enforced it will prevent the very practices which it was intended to prevent. (See Geofroy vs. Riggs, 133 U. S., 258 at p. 270).

The plain meaning of the treaty and the only meaning consistent with its purpose is the meaning which protects our name and property. It would have been stated no more plainly had it read:

> "A name valid in the country of origin shall be protected in all countries of the union without obligation of deposit,"

or to put the concrete case

> "A name valid in France shall be protected in the United States."

Necessarily protection under the treaty depends on the status of the name in the country of origin and on it alone. Otherwise the provision is a nullity and the words "without obligation of deposit" an absurdity.

Protection depending on the status of the word here existed without the treaty. It should not be reasoned that the intention in making the treaty was to add nothing to rights already existing—to indulge in a piece of international pleasantry. The salient intent was to increase the protection of foreign names —to prevent their appropriation in other countries without compelling their owners to take steps (by registration or otherwise) to insure their protection in those countries.

By prescribing that the commercial name shall be protected in all countries of the Union reference is necessarily made to the country of origin to discover whether or not there exists a commercial name to be protected. If the name is a commercial name in the country of its origin it is entitled to protection. When it ceases to be a commercial name and becomes public property in the country of origin there is nothing to which the protection guaranteed by the treaty can attach, but as long as it remains a commercial name there the protection guarateed by the treaty will be afforded by the Courts.

In Saxlehner vs. Eisner and Mendelson *(supra)* the Court reasoned that because the name "Hunyadi" had become "public property in the Kingdom of Hungary" in view of the plain terms of that treaty "it is difficult to escape the conclusion that it also became so here." We submit that because the name "Vichy" is the undisputed "commercial name" of the complainants in France in view of the plain terms of this treaty it is difficult to escape the conclusion that it will be "protected" here.

The unmistakable intent of the treaty was to prevent the loss by foreigners of their commercial names,

whether the loss should result from anticipatory use, infringement or spoliation.

By this provision the plaintiffs were guaranteed the right to sell "Vichy" as "Vichy" in the markets of the United States. That right was a continuing right imposing no duty to enter those markets at any particular time, but lasting as long as the word was a commercial name in France unimpaired by the practices here which the treaty was framed to prevent, no matter how long continued.

The protection securing that right may be invoked whenever the owners of the name may elect, whether they are sending their first bottle of water to our markets or (because of the improvement in transportation, the accumulation of wealth and the increasing appreciation of the genuine water) are extending their operations.

Assuming for the sake of the argument much more than the defendant can conceivably claim concerning the uses of the word "Vichy" it may be said that the situation in effect is this: By the dextrous use of fraudulent misrepresentations the owners of the Vichy Springs have been headed off from the markets of the United States.

We submit that even if it can be said that Equity (unaffected by legislative action) will protect the defendant in holding on to the tool used to bring about this result, we may invoke the statutory protection guaranteed by the treaty which cannot be defeated by showing the existence of the very abuses which it is its purpose and function to prevent.

There is no material defense but laches. We submit that as affecting our right to protection under the treaty that defense is without application.

In conclusion, we respectfully submit that the case may be summarized as follows:

The name "Vichy" is an inseparable incident in marketing the waters of the Vichy Springs and an essential part of the property owned by the Republic of France. The use of the name which the decree sanctions in effect makes it impossible to sell genuine "Vichy" in the markets of the United States and thus impairs the value of the Vichy Springs. In substance and effect the decree takes from its owner and delivers over to the wrong-doers who have laid hold of it part of the value of the land owned by the French Republic. We submit that the whole weight and reason of the common law and the plain dictate of the treaty preclude the acceptance of this result.

There is a narrow and a broad view of the case: The narrow view makes delay imputed to a sovereign state the only material consideration. The broad view proceeds upon the assumption that as long as the truthful use of a name can be differentiated from its use in a spurious relation, equity will protect the truth.

We most respeatfully submit that the case should be remanded to the Court below with instructions to extend the decree so as to restrain the use of the word "Vichy" as prayed in the bill of complaint.

Respectfully submitted,

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